

**REMARKS**

Claims 1-20 were previously pending, of which no claims have been cancelled, and no new claims have been added. Claims 2, 5, 8, 12, 15 and 18 are amended to correct certain clerical errors. Consequently, claims 1-20 are currently pending in the present application.

Favorable consideration of claims 1-20 is respectfully requested in light of the following remarks.

**Rejection Under 35 U.S.C. §103(a)**

Claims 1-20 were rejected under 35 U.S.C. §103(a) over WO 99/35368 to Lohbeck et al. ("Lohbeck") in view of United States Patent No. 4,573,540 to Dellinger et al. ("Dellinger"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

Independent claim 1 recites a method of forming a wellbore casing within a borehole that traverses a subterranean formation. The method of claim 1 includes:

positioning a first wellbore casing within and coupling the first wellbore casing to the borehole;

positioning a second wellbore casing within the borehole that overlaps with and is coupled to the first wellbore casing;

positioning a tubular liner within the borehole that overlaps with and is coupled to at least a portion of the second wellbore casing;

extending the length of the borehole;

decoupling the tubular liner from the second wellbore casing and removing the tubular liner from the borehole; and

positioning a third wellbore casing within the borehole that overlaps with and is coupled to the second wellbore casing.

Each of claims 2-10 depends directly or indirectly from claim 1 and therefore includes at least the foregoing elements.

Independent claim 11 recites a system for forming a wellbore casing within a borehole that traverses a subterranean formation. The system of claim 11 includes:

means for positioning a first wellbore casing within and coupling the first wellbore casing to the borehole;

means for positioning a second wellbore casing within the borehole that overlaps with and is coupled to the first wellbore casing;

means for positioning a tubular liner within the borehole that overlaps with and is coupled to at least a portion of the second wellbore casing;

means for extending the length of the borehole;

means for decoupling the tubular liner from the second wellbore casing and removing the tubular liner from the borehole; and

means for positioning a third wellbore casing within the borehole that overlaps with and is coupled to the second wellbore casing.

Each of claims 12-20 depends directly or indirectly from claim 11 and therefore includes at least the foregoing elements.

To sustain a rejection of claims 1-20 under 35 U.S.C. § 103(a), a *prima facie* case of obviousness must be established. MPEP § 2142 provides that a *prima facie* case of obviousness requires three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

As the PTO also recognizes in MPEP § 2142:

*... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

**1. The recognition of a problem, or of the source of the problem, is not obvious even though the solution to the problem may be obvious**

In the present case, it is apparent from a reading of Lohbeck and Dellinger that neither recognize the problem of a risk of a collapse in the lower wellbore casing during subsequent drilling operations. As recognized in the specification of the pending application (see, e.g., paragraphs [004] and [0020]), one of the benefits of the coupling of the tubular liner 18 to the second wellbore casing 16 is to reduce the risk of a collapse of the second wellbore casing during subsequent drilling operations. In this regard, and as noted above, claims 1 and 11 currently recite: positioning or means for positioning a tubular liner within the borehole, wherein the tubular liner is coupled to at least a portion of the second (lower) wellbore casing; extending or means for extending the length of the borehole (i.e., continuing drilling operations); and decoupling or means for decoupling the liner from the second casing and removing the liner, among other elements.

In this context, Lohbeck acknowledges that the production liner and the casing structure can mutually reinforce each other. However, the Lohbeck production liner is installed only after the borehole is completely drilled and fully cased. Thus, Lohbeck clearly failed to recognize the problem of a potential collapse in the lower wellbore casing during subsequent drilling operations. Consequently, as the Examiner concedes, Lohbeck fails to teach or suggest: positioning or means for positioning a tubular liner within the borehole; extending or means for extending the length of the borehole; and decoupling or means for decoupling the liner from the second casing and removing the liner, among other elements of claims 1 and 11 of the present application.

Dellinger teaches protecting previously installed casing during subsequent drilling operations. However, the intended function is protecting previously installed casing from wear caused by rotation of the drill string, and Dellinger only suggests using the radially inward spaced liner during directional drilling because the drill string only wears on the previously installed casing during directional drilling (e.g., in contrast to vertical drilling). Consequently, Dellinger

also failed to recognize the problem of a potential collapse in the lower wellbore casing during drilling operations.

Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant, and is part of the “subject matter as a whole” language of 35 USC § 103(a) which should always be considered in determining the obviousness of an invention under this statute. Because neither Lohbeck nor Dellinger recognize the problem of a potential collapse in the lower wellbore casing during drilling operations, the references cannot be combined to support a *prima facie* case of obviousness of independent claims 1 and 11 of the present application.

Thus, for this independent reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met with respect to claims 1 and 11 nor claims 2-10 and 12-20 which depend therefrom. Therefore, the rejection of claims 1-20 under 35 U.S.C. §103(a) over Lohbeck in view of Dellinger should be withdrawn.

## **2. The Combination of References is Improper**

There is another, mutually exclusive, and compelling reason why the Lohbeck and Dellinger references cannot be applied to reject independent claims 1 and 11 under 35 U.S.C. § 103(a).

Specifically, as provided by MPEP § 2142:

*...the Examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.....The Examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole’.*

Here, neither Lohbeck nor Dellinger teaches, or even suggests, the desirability of the combination of positioning or means for positioning a tubular liner within the borehole that overlaps with and is coupled to at least a portion of the second wellbore casing; extending or means for extending the length of the borehole; decoupling or means for decoupling the tubular

liner from the second wellbore casing and removing the tubular liner from the borehole; and positioning or means for positioning a third wellbore casing within the borehole that overlaps with and is coupled to the second wellbore casing, as specified above and as set forth in independent claims 1 and 11.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103(a) rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination can arise solely from hindsight based on the invention because there is no showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1 and 11.


Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met with respect to claims 1 and 11 nor claims 2-10 and 12-20 which depend therefrom. Therefore, the rejection of claims 1-20 under 35 U.S.C. §103(a) over Lohbeck in view of Dellinger should be withdrawn.

**Conclusion**

It is clear from all of the foregoing that independent claims 1 and 11 are in condition for allowance. Dependent claims 2-10 and 12-20 depend from and further limit independent claims 1 and 11 and therefore are allowable as well.

An early formal notice of allowance of claims 1-20 is requested.

Respectfully submitted,



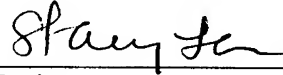
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